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09/474,317	12/29/1999	Gregg Homer	12961	2106

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EXAMINER

MIRZA, ADNAN M

ART UNIT

PAPER NUMBER

2141

B

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/474,317	HOMER, GREGG
	Examiner Adnan M Mirza	Art Unit 2141

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 24 March 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 1-26 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-26 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabbard et al (U.S. 6,205,432) and in view of Eggleston et al (U.S. 6,101,531).

As per claims 1,7,10,20,22 Gabbard disclosed a method for tracking the transmission of a digital file over the Internet comprising the steps of: receiving packets constituting segments of the file in transit over the Internet; examining file headers in said packets to determine the presence of specific identifying indicia therein (col. 12, lines 2-30); and.

However Gabbard failed to disclose recording the Internet Protocol header source address for each of the packets containing said specific identifying indicia. In the same field of endeavor Eggleston disclosed recording the Internet Protocol header source address for each of the packets containing said specific identifying indicia (col. 8, lines 22-63).

It would have been obvious to one ordinary skill in the art at the time that invention was made to have incorporated recording the Internet Protocol header source address for each of the packets containing said specific identifying indicia as taught by Eggleston in the method of Gabbard to make the method more secure and reduce latency in processing the packets.

3. As per claim 2 Gabbard-Eggleston disclosed including the additional step of recording the Internet Protocol header destination address for the file (Eggleston, col. 8, lines 22-63).

4. As per claims 3,4 Gabbard-Eggleston disclosed including the additional step of transmitting said identifying indicia and said source Internet address to a proprietor of the file (Eggleston, col. 12, lines 43-67).

5. As per claims 5,8,21 Gabbard-Eggleston disclosed wherein said examining step further includes: searching said file headers for TCP headers containing port numbers indicative of an email message; searching each of said packets (Gabbard, col. 11, lines 45-67), in which port numbers indicative of email messages were found, for an attachment; and when said attachment is found, locating the source Internet address in an IP header for the file containing the attachment (Gabbard, col. 12, lines 1-32).

6. As per claims 6,9,13,26 Gabbard-Eggleston disclosed wherein said identifying indicia comprises a user defined character sequence selected from the group consisting of: an extension to an existing file format, prepended to the file; a sequence of bits embedded in the file; and an absence of code in a predefined area within the file (Gabbard, col. 16, lines 24-42).

7. As per claim 11, this claim differ from the claim 1 in that recording step, e.g. claim 1 recites “recording the Internet Protocol header source address” and claim 11 recites the same thing with different wording therefore, it is rejected accordingly.

8. As per claim 12 Gabbard-Eggleston disclosed wherein said examining step further includes: searching said file headers for TCP headers containing port numbers indicative of email messages (Gabbard, col. 11, lines 17-32); searching each of said packets, in which port

numbers indicative of email messages were found, for a MIME header indicative of an attachment (Gabbard, col. 12, lines 1-7); and when said MIME header indicative of an attachment is found: searching a header directly prepended to the file to find said identifying indicia therein, when said MIME header is indicative of an attachment containing a type of said file sought; and locating the source Internet address in an IP header for the file containing the attachment, when said identifying indicia is found (Gabbard, col. 12, lines 7-67).

9. As per claim 14 Gabbard-Eggleston disclosed substantially the invention including a method for tracking the transmission of a digital file over the Internet comprising the steps of: placing identifying indicia in said digital file; using a data communications monitoring device to capture packets of information being transmitted via the Internet (Gabbard, col. 12, lines 2-30); examining certain ones of said packets to determine the presence of said identifying indicia in said file (Eggleston, col. 12, lines 47-57); and recording the source and destination Internet addresses for each of the packets containing said identifying indicia, and the identity of the file associated therewith (Eggleston, col. 8, lines 22-63).

10. As per claim 15 Gabbard-Eggleston disclosed wherein said identifying indicia is prepended to said header (Eggleston, col. 10, lines 34- 40).

11. As per claim 16 Gabbard disclosed wherein said identifying indicia is embedded in said file (col. 12, lines 3-32).

12. As per claim 17 Gabbard-Eggleston disclosed the invention substantially including a method for tracking the transmission of a digital file over the Internet comprising the steps of: receiving packets constituting segments of the file in transit over the Internet; searching said packets for TCP headers containing port numbers indicative of email messages (Gabbard, col.

11, lines 17-32); searching each of said packets, in which said port numbers indicative of email messages were found, for a MIME header indicative of an attachment; and when said MIME header indicative of an attachment is found (Gabbard, col. 12, lines 1-7): searching a header directly prepended to the file to locate said identifying indicia therein, when said MIME header is indicative of an attachment containing a type of said file sought; locating the source Internet address in an IP header for the file containing the attachment containing the type of said file sought, when said identifying indicia is located; and recording, for each of the packets containing said identifying indicia, the source Internet address for the file (Eggleston, col. 8, lines 22-63).

13. As per claims 18,19 Gabbard-Eggleston disclosed including the additional step of transferring said identifying indicia and said source Internet address to a proprietor of the file (Eggleston, col. 8, lines 22-63).

14. As per claim 23 Gabbard-Eggleston disclosed wherein said identifying indicia is located in a header having a field indicating that the frame size thereof is zero bytes in length (Eggleston, col. 8, lines 45-50).

15. As per claims 24,25 Gabbard-Eggleston disclosed wherein said identifying indicia is located in a header having a frame size field indicating that there is no information field appended to the frame size field (Eggleston, col. 10, lines 34-40).

Applicant Arguments are as follows:

16. Applicant argued that following parts of the claims have not been disclosed.

As to applicants arguments the following parts of the claims has been disclosed by the prior art.

1. The combination of examining file headers in file packets being transmitted over Internet for specific identifying indicia and recording the IP header source address for each packet containing the indicia (Eggleson, col. 8, lines 22-36). Eggleson taught different attributes in the header where these attributes included priority values and client Identification values.
2. The above combination including recording the IP destination address for the file (Eggleson, col. 8, lines 22-63). Eggleson taught all different values such as different attributes can be assigned and stored.
3. The first combination including transmitting the identifying indicia and the source to a proprietor of the file (Eggleson, col. 12, lines 55-63).
4. The first combination wherein the examining includes searching the file headers for TCP headers having port numbers indicative of email messages, searching those packets for attachments, and locating the source Internet address in an IP header for files containing the attachments (col. 12, lines 55-63).
5. The above combinations wherein the searching for attachments includes searching for MIME headers indicative of attachments, and searching a directly prepended file header for the identifying indicia when the MIME header indicates an attachment having a sought file type (Gabbard, col. 10, lines 1-32).

6. The first combination wherein the identifying indicia includes a prepended extension to an existing file format, an imbedded bit sequence, or absence of code in predefined file area (Gabbard, col. 16, lines 24-42).

7. A system including a server, a monitor, and either a router or a modem, wherein the monitor is programmed to perform the process of the first combination (Gabbard, col. 12, lines 2-30).

8. The above system wherein the monitor is further programmed according to the fourth combination (Gabbard, col. 12, lines 1-32).

9. The above system wherein the identifying indicia includes a prepended extension to an existing file format, an imbedded bit sequence, or absence of code in a predefined file area (Gabbard, col. 16, lines 24-42).

17. Applicant argued that there is no *prima facie* case of obviousness not only because a combination of references fails to provide applicants invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Eggleston and Gabbard both prior art reading on selecting email or messages on the basis of the client profile and selected attributes. Where Eggleston using different value to select different messages.

### ***Conclusion***

**18. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Adnan Mirza whose telephone number is (703)-305-4633.

20. The examiner can normally be reached on Monday to Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703)-305-4815. The fax for this group is (703)-746-7239.

21. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)-746-7239 (For Status Inquiries, Informal or Draft Communications, please label "PROPOSED" or "DRAFT");

(703)-746-7239 (For Official Communications Intended for entry, please mark "EXPEDITED PROCEDURE"),

(703)-746-7238 (For After Final Communications).

22. Any Inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

Any response to a final action should be mailed to:

BOX AF

Commissioner of Patents and Trademarks Washington, D.C.20231

Or faxed to:

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Art Unit: 2141

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Hand-delivered responses should be brought to 4<sup>th</sup> Floor Receptionist, Crystal Park II,  
2021 Crystal Drive, Arlington, VA 22202.

AM

Adnan Mirza

Examiner

B. J. H. D.

B.Jaroechonwanit

Primary Examiner